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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,419	02/12/2002	Takanari Tominaga	1422-0514P	1153

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EXAMINER	
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ART UNIT	PAPER NUMBER
1623	

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N . 10/049,419	Applicant(s) TOMINAGA ET AL.	
	Examiner Kathleen Kahler Fonda, Ph.D.	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *2-12-02 (IDS and prel amdt)* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☒ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Applicant will note that the cover sheet for this Office action indicates that not all priority documents have been received from the International Bureau. Although Japanese application 2000-69223 03/13/2000 is in the file, Japanese application 11-234262 08/20/1999 is not. The Examiner is attempting to obtain a copy of the missing document from the International Bureau.

Claims 3-5, 7, 8, and 10 are objected to under 37 CFR 1.75 as being substantial duplicates of claim 1. When two or more claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Each of claims 22 and 24-27 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/148,486, now published as US 2002/0039670. Although the conflicting claims are not identical in that copending claim 1 recites a sulfated monosaccharide and a salt of fucoidan not mentioned in the instant claims, they are not

patentably distinct from each other because both the pending claims and the copending claims recite cosmetics comprising fucoidan or a degradation product thereof. Statements of intended use do not distinguish the claims.

Each of claims 8 and 10-13 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10/148,486, now published as US 2002/0039670. Although the conflicting claims are not identical in that copending claim 9 recites a sulfated monosaccharide and a salt of fucoidan not mentioned in the instant claims, they are not patentably distinct from each other because both the pending claims and the copending claims recite foods or beverages comprising fucoidan or a degradation product thereof. Statements of intended use do not distinguish the claims.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple

assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14, 15, 18, 19, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are non-statutory because "use" is not a statutory class of invention. The claimed recitation of a use, without setting forth any steps involved in

the process, results in an improper definition of a process; the claims are not proper process claims under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 15, 18, 19, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 14, 15, 18, 19, and 21 provide for the use of fucoidan, but since the claims do not set forth any steps involved in any process, it is unclear what Applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 15, and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by UMEDA *et al*. (A). UMEDA teaches a tea preparation comprising fucoidan derived from *Kjellmaniella crassifolia* in Example 6. Applicant is advised that a statement of intended use such as "for a disease . . ." in claim 1 is not sufficient to distinguish over the composition of the reference. Thus, attempts to limit the intended use,

such as specifying a particular cytokine, also do not distinguish over the cited art.

Claims 22-27 are rejected under 35 U.S.C. 102(a) as being anticipated by TAKO (N). Because the document is in Japanese, the Examiner relies in part on Derwent abstract 1999-106003 as an indication of its contents. TAKO teaches that fucoidan can be obtained from algae and formulated as a cosmetic. See the Derwent abstract and the English language abstract of WO99/01478. As stated above, a statement of intended use such as "for regulation . . ." in claim 22 is not sufficient to distinguish over the composition of the reference. Thus the claims are anticipated.

Claims 14, 16, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by PARISH *et al.* (B). PARISH teaches that administration of fucoidan can prevent experimental allergic encephalomyelitis, which is an allergic disease. See column 1, lines 36-41. Thus the claims are anticipated.

Claims 14, 16, 20, and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by GRANERT *et al.* (AE). GRANERT teaches that administration of fucoidan can inhibit

release of TNF-α and IL-1, which are cytokines. See the abstract and the left column on page 2072. Thus the claims are anticipated.

Claims 14, 16, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by KYODO NYUGYO KK (AB). Because the document is in Japanese, the Examiner relies in part on the Patent Abstracts of Japan English language abstract as an indication of its contents. KYODO NYUGYO KK teaches that administration of fucoidan can treat or prevent allergic disease and can suppress production of interleukin 4, which is a cytokine. See the English language abstract. Thus the claims are anticipated.

No claim is allowed.

Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The number of the fax machine for official papers in Technology Center 1600 is (703) 308-4556. Any document submitted by facsimile transmission will be considered an official communication unless the cover sheet clearly indicates that it is an informal communication.

INTERNET INFORMATION: Secure and confidential access to patent application status information is now available; see http://www.uspto.gov/ebc/index.html for more information. Also, http://www.uspto.gov/web/offices/ac/comp/fin/clonedefault.htm may be used to pay patent maintenance fees, pay non-filing application fees, and maintain USPTO deposit accounts.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kathleen Kahler Fonda, at telephone number (703) 308-1620. Examiner Fonda can generally be reached Monday through Friday from 7:30 a.m. until 4:00 p.m. If the Examiner cannot be reached, questions may be addressed to Supervisory Patent Examiner James O. Wilson at (703) 308-4624. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-1235.

Kathleen Kahler Fonda, Ph.D., J.D.
Primary Examiner
Art Unit 1623